

REMARKS

The Final Office Action mailed December 9, 2008 noted that claims 1-11 were pending, constructively withdrew claim 11 from consideration, and rejected claims 1-10. Claims 1, 3, 4, 5, 7, 8, 9, 10, and 11 are amended. No claims are cancelled. No new claims are added. No new matter is believed to be presented.

Claims 1-11 are pending and under consideration. The rejections are respectfully traversed below.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because: the amendments include removal of informalities; the amendments were not earlier presented because the Applicants believed in good faith that the cited references did not disclose the present invention as previously claimed; the amendments of the claims should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised because the claims are merely amended to clarify that the inventory refers to hardware and software of a computer. The Applicant amends the claims to advance prosecution and merely to clarify that a client is not a customer, but rather a computer.

Response to Constructive Election/Restriction

The Office Action, on page 2, constructively elected claims 1-10 for prosecution on the merits and withdrew claim 11 from consideration as being directed to a non-elected invention. Particularly, the Office Action asserted "[claim 11] has separate utility such as the manager is provided with a policy rating based upon a number of clients operating under the corresponding policy, overall operation time of the corresponding policy among the plurality of clients, and a number of application[s] running on the client to be managed." However, it is submitted that the assertion by the Office Action is incorrect.

According to MPEP § 821.03, if, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144. However, in this case, claim 11 is neither independent nor distinct from the

previously presented claims. According to MPEP § 802.01, the term "independent" means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. See also MPEP § 806.06 and § 808.01.

Claim 1 recites "upon receiving selection information indicating the selection by the manager of at least one operations management policy from said created policy list, retrieving from said database, the operations management policy specified by said selection information; and transmitting the retrieved operations management policy to the computer to be managed."

Claim 11 recites "providing the created policy lists to a manager of the computer network system for a selection of one policies for each computer to be managed, **wherein the manager is provided with a policy rating based upon a number of computers operating under the corresponding policy, overall operation time of the corresponding policy among the plurality of computers, and a number of applications of the corresponding policy**; upon receiving the selection from the manager, retrieving from the database, the operations management policy specified by the selection; and sending the retrieved operations management policy to each computer to be managed."

Claim 1 and 11 recite very similar features except that claim 11 recites an additional claim limitation related to dependent claim 4 with additional details referring to the information which is provided to the manager to use to make a selection for the computer to be managed. Claim 4 recites "said usage frequency comprises: the number of references, the operating time and the number of applications of each of the operations management policies applied to said computer to be managed." Claim 11 recites "the manager is provided with a policy rating based upon a number of computers operating under the corresponding policy, overall operation time of the corresponding policy among the plurality of computers, and a number of applications of the corresponding policy."

According to MPEP § 802.01, related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.

Both claim 1 and 11 are connected in design, operation, and effect because both claim 1

and 11 are related to a manager managing a network of computers and the manager's selection of a management policy which is to be sent to a computer to be managed. Claim 11 simply contains an additional limitation that is not found in claim 1, which is similar to the claim limitation found in dependent claim 4 and is discussed in paragraph [0036] of the Application.

Thus claim 11 is not distinct from claims 1-10 and withdrawal of the election/restriction requirement is respectfully requested.

Rejection under 35 U.S.C. § 102

The Office Action, on page 6, in item 20, rejected claims 1-5 and 7-10 under 35 U.S.C. § 102(b) as being anticipated by Brinkley (U.S. Patent Number 5,963,919). This rejection is respectfully traversed below.

Brinkley discusses an inventory management system and method that can be used to properly stock the correct amount of goods to be sold. Brinkley notes that inventory management tools typically apply a single strategy to an entire inventory portfolio and fail to take into consideration differing needs and the importance of various types of goods. Some goods may require a large quantity of inventory stock while other may be manufactured or replenished only when customer order the goods. (See Brinkley, column 1, lines 45-55, column 2, lines 40-51).

The pending claims are merely amended to clarify their distinguishing features. In light of the above discussion, it is respectfully submitted that claim 1, patentably distinguishes over Brinkley, because nothing found or cited in Brinkley discloses:

receiving inventory information **specifying an inventory based upon one of hardware and software of a computer to be managed**, retrieving from a database, operations management policies corresponding to the specified inventory and creating a policy list detailing operations management policies suited to the inventory specified by said inventory information.

The Office Action, on page 6, asserts that the above features are disclosed by column 4, lines 35-61, and column 5, line 16 – column 7, line 50 of Brinkley. However, Brinkley is merely related to an inventory management system that manages inventory replenishment of goods which uses a computer. Brinkley refers to the various replenishment strategies including materials requirements planning (MRP), manufacturing resources planning (MRP II), distribution requirements planning (DRP), just-in-time production (JIT), Kanban, supplier-managed inventory, consignment, statistical inventory control, and time-phased reorder point. Brinkley notes that the above phrases used can be eliminated in favor of make-to-order, replenish-to-order, warehouse

replenishment, fixed-rate supply, multi-input expert planning, and forecast optimal.

The claims have been amended to recite "**computer**" rather than "client." Brinkley does not disclose "receiving an inventory information **specifying an inventory based upon one of hardware and software of a computer to be managed.**" In other words, inventory information of claim 1 refers to the hardware connected to a computer and software of a computer. Operations management policies suited to inventory or configuration of a computer including the hardware and software of a computer are then created. Thus the "inventory" of Brinkley is very different from the "inventory" of a computer including hardware and software as in claim 1. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because Brinkley does not disclose all features of claim 1, Brinkley cannot anticipate claim 1.

Independent claim 5 is amended to clarify its distinguishing features which are not disclosed by Brinkley including "upon receiving inventory information specifying an **inventory based upon one of hardware and software of a computer to be managed**, retrieving from a database, operations management policies corresponding to the specified inventory and acquiring operations management policies suited to the inventory specified by said inventory information." Thus, claim 5 is not anticipated by Brinkley.

Independent claim 7 is amended to clarify its distinguishing features which are not disclosed by Brinkley including "list creating means for, upon receiving inventory information specifying an **inventory based upon one of hardware and software of a computer to be managed**, retrieving policies from said database and creating a policy list detailing operations management policies suited to the inventory specified by said inventory information." Thus claim 7 is not anticipated by Brinkley.

Independent claim 8 is amended to clarify its distinguishing features not disclosed by Brinkley including "policy retrieving means for, upon receiving inventory information specifying an **inventory based upon one of hardware and software of a computer to be managed**, retrieving from said database, operations management policies suited to the inventory specified by said inventory information." Thus claim 8 is not anticipated by Brinkley.

Independent claim 9 is amended to clarify its distinguishing features not disclosed by Brinkley including "a list creating function for, upon receiving inventory information specifying an **inventory based upon one of hardware and software of a computer to be managed**,

retrieving from a database, storing operations management policies corresponding to the specified inventory and creating a policy list detailing operations management policies suited to the inventory specified by said inventory information." Thus claim 9 is not anticipated by Brinkley.

Independent claim 10 is amended to clarify its distinguishing features not disclosed by Brinkley including "a policy acquiring function for, upon receiving inventory information specifying **an inventory based upon one of hardware and software of a computer to be managed**, retrieving from a database, storing operations management policies corresponding to the specified inventory and acquiring a policy list detailing operations management policies suited to the inventory specified by said inventory information." Thus claim 10 is not anticipated by Brinkley.

Currently withdrawn claim 11 is amended to clarify its distinguishing features not disclosed by Brinkley including "receiving **a configuration based upon one of hardware and software from each computer to be managed**" and "providing the created policy lists to a manager of the computer network system for a selection of one policy for each computer to be managed, wherein the manager is provided with a policy rating based upon a number of computers operating under the corresponding policy, overall operation time of the corresponding policy among the plurality of computers, and a number of applications of the corresponding policy." Thus claim 11 is not anticipated by Brinkley.

The dependent claims depend from the above-discussed independent claims and are not anticipated by Brinkley for the reasons discussed above. The dependent claims also recite additional features not disclosed by Brinkley. For example, claim 4 recites "said usage frequency comprises: the number of references, the operating time and the number of applications of each of the operations management policies applied to said computer to be managed." In particular, Brinkley does not disclose any features of claim 4. It is submitted that the dependent claims are independently patentable over Brinkley.

Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103

The Office Action, on page 10, in item 22, rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Brinkley and further in view of Hoffman (U.S. Patent Number 7,120,596). This rejection is respectfully traversed below.

Hoffman discusses a supply chain management system and nothing cited or found in

Hoffman cures the deficiencies of Brinkley discussed above. Thus dependent claim 6 patentably distinguishes over Brinkley and Hoffman, taken alone or in combination for the reasons discussed above.

Summary

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the cited references. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.


If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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